



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JIGJr: 07-05

Paper No: __

MORGAN & FINNEGAN, L.L.P.
3 WORLD FINANCIAL CENTER
NEW YORK NY 10281-2101

COPY MAILED

JUL 26 2005

OFFICE OF PETITIONS

In re Application of	:
Ellenberg, et al.	:
Application No. 09/624,439	: DECISION ON PETITION
Filed: 24 July, 2000	:
Attorney Docket No.: 3951-4001	:

This is a decision on the petition filed on 9 May, 2005, under 37 C.F.R. §1.183, to waive provisions of 37 C.F.R. §1.131.

For the reasons set forth below, the petition under 37 C.F.R. §1.183 to waive provisions of 37 C.F.R. §1.131 is **GRANTED in part** and **DISMISSED in part**.

BACKGROUND

The record reflects that:

- the instant application was received and given a filing date of 24 July, 2000, and included on filing a fully executed oath/declaration; however, in response to non-final rejections mailed, respectively, on 19 March and 23 September, 2004, Petitioner sought to submit a declaration pursuant to 37 C.F.R. §1.131, however, the Examiner has objected to the declaration in that only one co-inventor has signed the document;
- in an effort to have the declaration pursuant to 37 C.F.R. §1.131 entered, Petitioner found that a named co-inventor, Josh Nabozny (Mr. Nabozny) is no longer in the employ of the assignee and Petitioner filed, *inter alia*, his statement as to efforts made to locate and

obtain a signed §1.131 declaration of Mr. Nabozny analogizing his efforts to and using the procedures of 37 C.F.R. §1.47, however, the regulations at 37 C.F.R. §1.47 are not to be used for this purpose, and the petition was dismissed on 7 March, 2005, for Petitioner to seek remedy by a waiver under 37 C.F.R. §1.183¹ of the requirements for all (both) inventors to sign the declaration under 37 C.F.R. §1.131.

In the renewed petition, Petitioner alleges that:

- one of the two named inventors, Josh Nabozny (Mr. Nabozny) is no longer in the employ of the assignee and has refused to sign the declaration under 37 C.F.R. §1.131; and
- seeks acceptance of the declaration with the signature of only the remaining inventor, Jonathan Ellenburg (Mr. Ellenburg);
- he diligently has sought to contact Mr. Nabozny;
- identified what he has identified and believes to be Mr. Nabozny's current mailing address(es);
- written to Mr. Nabozny in an effort to be able to present to him with the declaration under 37 C.F.R. §1.131, with a request that Mr. Nabozny review and sign the declaration;
- received no response from Mr. Nabozny and/or that Mr. Nabozny otherwise has failed to sign the declaration.

ANALYSIS

Having failed to file a fully executed declaration under 37 C.F.R. §1.131, Petitioner has attempted to approximate the showing of that under 37 C.F.R. §1.47 (though the provisions of 37 C.F.R. §1.47, *per se*, are not applicable in this manner).

Petitioner represents that he has made a diligent effort to contact Mr. Nabozny and have him join in the declaration under 37 C.F.R. §1.131, but that Mr. Nabozny has failed to do so and that this failure (and so creates an "extraordinary situation" as foreseen under 37 C.F.R. §1.183 requiring the invocation of the interests of justice).

¹ The regulations at 37 C.F.R. §1.183 provide, in pertinent part:

§1.183 Suspension of the Rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. * * *

To the extent that such waiver under 37 C.F.R. §1.183 is required so that the Examiner may now consider the declaration under 37 C.F.R. §1.131 as submitted, the petition is **granted** to permit such consideration; and in all other respects the petition is **dismissed**,

This file is released to Technology Center 3600 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

A handwritten signature in black ink, appearing to read "John J. Gillon, Jr.", with a stylized, looping flourish extending from the end.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions